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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,573	08/07/2001	Dwip N. Banerjee	AUS920010318US1	2690
45440	7590	01/14/2005	EXAMINER	
IBM CORPORATION (SS) C/O STREETS & STEELE 13831 NORTHWEST FREEWAY, SUITE 355 HOUSTON, TX 77040			ABEL JALIL, NEVEEN	
		ART UNIT	PAPER NUMBER	2165

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/923,573	BANERJEE ET AL.	
	Examiner Nev en Abel-Jalil	Art Unit 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 9/28/2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4,7-12,14,16,17,19-22,25-30,32,34 and 36-39 is/are rejected.
- 7) Claim(s) 5,6,13,15,18,23,24,31,33 and 35 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/11/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. The Request for Reconsideration filed on September 28, 2004 has been received and entered. Claims 1-39 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 1-4, 7-12, 14, 16, 17, 19-22, 25-30, 32, 34, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (U.S. Pub. No. 2003/0208429 A1) in view of Tolopka (U.S. Patent No. 6,064,976).

As to claims 1, and 19, Bennett discloses a computer program product including instructions embodied on a computer readable medium, the instructions comprising:
maintaining instructions for maintaining identification for a group of decision making entities in a memory device (See figure 2-1, shows “job classification”);
maintaining instructions for maintaining a setpoint representing a minimum cumulative support required to implement a proposed action (See page 6, paragraphs 0130-0132);

determining instructions for determining the cumulative (See page 7, paragraphs 0136-0139);

communicating instructions to the plurality of decision-making entities (See page 4, paragraph 0102);

receiving instructions for receiving from the plurality of decision-making entities, wherein each response includes an indicator of support for the proposed action (See page 12, paragraphs 0259-0266);

implementing instructions for automatically implementing the decision if the cumulative support is greater than the setpoint (See page 7, paragraphs 0136-0137).

Bennett does not teach from the query responses received; for communicating a query; responses to the query; and wherein the query includes a description of the proposed action.

Tolopka teaches from the query responses received; for communicating a query; responses to the query; and wherein the query includes a description of the proposed action (See column 2, lines 13-64, also see column 4, lines 46-59, also see column 5, lines 23-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bennett to include from the query responses received; for communicating a query; responses to the query; and wherein the query includes a description of the proposed action.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bennett by the teaching of Tolopka to include from the query responses received; for communicating a query; responses to the query; and wherein the query

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includes a description of the proposed action because it provides for efficient method for data retrieval and access of records in a database.

As to claims 2, and 20, Bennett as modified discloses further comprising communicating messages to one or more of the decision-making entities (See page 4, paragraph 0099).

As to claims 3, and 21, Bennett as modified further comprising communicating messages from one or more of the decision-making entities to at least one different decision-making entity (See page 4, paragraph 0099).

As to claims 4, and 22, Bennett as modified wherein the indication of support is of a type selected from qualitative, quantitative, functional or a combination thereof (See page 4, paragraph 0099).

As to claims 7, and 25, Bennett as modified further comprising: initiating an intra-group caucus between a plurality of the decision-making entities (See pages 7-8, paragraphs 0149-0151).

As to claims 8, and 26, Bennett as modified further comprising: receiving a request from one of the decision-making entities to initiate a query, wherein the request includes the proposed action (See Tolopka column 2, lines 13-64, also see column 4, lines 46-59).

As to claims 9, and 27, Bennett as modified wherein the query is formulated by one of the plurality of decision-making entities (See Tolopka column 2, lines 13-64, also see column 4, lines 46-59) and transmitted to a central coordinator for subsequent communication to the plurality of decision-making entities (See page 7, paragraphs 0146-0148).

As to claims 10, and 28, Bennett as modified wherein the setpoint is established by the decision making entity that formulates the query (See page 7, paragraph 0139, also see Tolopka column 2, lines 13-64, also see column 4, lines 46-59).

As to claims 11, and 29, Bennett as modified wherein the step of implementing the decision comprises transmitting an electronic communication to a third party (See page 4, paragraph 0099).

As to claims 12, and 30, Bennett as modified wherein the identification of each decision-making entity includes a weighting factor (See page 3, paragraph 0080, and see page 13, paragraph 0277); and

wherein the step of determining the cumulative support includes applying the weighting factor against each indicator of support for the decision (See page 4, paragraphs 0099-0105).

As to claims 14, and 32, Bennett as modified wherein the query responses include weighting factors or other criteria relevant to the level of support (See page 5, paragraphs 0111-0114, also see Tolopka column 5, lines 4-52, also see column 4, lines 46-59).

As to claim 16, Bennett as modified further comprising:
querying one of the plurality of decision-making entities for authorization to implement the decision if the query responses provide cumulative support greater than the minimum setpoint (See page 7, paragraphs 0136-0139, also see Tolopka column 5, lines 4-52, also see column 4, lines 46-59).

As to claims 17, and 34, Bennett as modified further comprising:
obtaining approval or denial to implement the decision (See page 6, paragraph 0132).

As to claim 39, Bennett as modified further comprising:
providing a collaboration manager to interface between decision-making entities having different computer platforms or applications (See page 7, paragraph 0146).

4. Claims 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (U.S. Pub. No. 2003/0208429 A1) in view of Tolopka (U.S. Patent No. 6,064,976) as applied to claims 1-4, 7-12, 14, 16, 17, 19-22, 25-30, 32, 34, and 39 above, and further in view of Lang et al. (U.S. Patent No. 6,694,007 B2).

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As to claim 36, Bennett as modified still does not teach wherein one or more of the plurality of decision-making entities communicates through a personal digital assistant.

Lang et al. teaches wherein one or more of the plurality of decision-making entities communicates through a personal digital assistant (See column 4, lines 4-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Bennett as modified to include wherein one or more of the plurality of decision-making entities communicates through a personal digital assistant.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Bennett as modified by the teaching of Tolopka to include wherein one or more of the plurality of decision-making entities communicates through a personal digital assistant because it provides mobility, far reach, and accessibility in reaching users.

As to claim 37, Bennett as modified still does not teach wherein the communications occur over a wireless network.

Lang et al. teaches wherein the communications occur over a wireless network (See column 4, lines 4-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Bennett as modified to include wherein the communications occur over a wireless network.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Bennett as modified by the teaching of Tolopka to include wherein the communications occur over a wireless network because it provides mobility, far reach, and accessibility in reaching users.

As to claim 38, Bennett as modified still does not teach wherein the communications utilize instant messaging.

Lang et al. teaches wherein the communications utilize instant messaging (See column 4, lines 4-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Bennett as modified to include wherein the communications utilize instant messaging.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Bennett as modified by the teaching of Tolopka to include wherein the communications utilize instant messaging because it provides mobility, far reach, and accessibility in reaching users.

Allowable Subject Matter

5. Claims 5-6, 13, 15, 18, 23-24, 31, 33, and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form **including** all of the limitations of the base claim and any intervening claims.

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6. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record (Katz et al. -U.S. Pub. 2002/0174000- and Chandra et al. -U.S. Patent No. 2002/0138582- and Bennett -U.S. Pub. No. 2003/0208429 A1- and Tolopka -U.S. Patent No. 6,064,976- and Lang et al. -U.S. Patent No. 6,694,007 B2) do not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim), wherein the step of automatically implementing the decision includes transmitting an instruction to one or more trading networks, as claimed in claim 5, in conjunction with remaining claims provisions.

Claims 13, and 15 are allowed over the prior art made of record, because it is dependent from the objected to as allowable dependent claim 5.

The prior art of record (Katz et al. -U.S. Pub. 2002/0174000- and Chandra et al. -U.S. Patent No. 2002/0138582- and Bennett -U.S. Pub. No. 2003/0208429 A1- and Tolopka -U.S. Patent No. 6,064,976- and Lang et al. -U.S. Patent No. 6,694,007 B2) do not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim), imposing arbitration among the plurality of decision-making entities if the query responses provide cumulative support less than the minimum setpoint value, as claimed in claim 6, in conjunction with remaining claims provisions.

The prior art of record (Katz et al. -U.S. Pub. 2002/0174000- and Chandra et al. -U.S. Patent No. 2002/0138582- and Bennett -U.S. Pub. No. 2003/0208429 A1- and Tolopka -U.S. Patent No. 6,064,976- and Lang et al. -U.S. Patent No. 6,694,007 B2) do not disclose, teach, or

suggest the claimed limitations of (in combination with all other features in the claim), imposing arbitration among the plurality of decision-making entities if the query responses provide cumulative support less than the minimum setpoint value, as claimed in claim 24, in conjunction with remaining claims provisions.

Claims 31, and 33 are allowed over the prior art made of record, because it is dependent from the objected to as allowable dependent claim 24.

The prior art of record (Katz et al. -U.S. Pub. 2002/0174000- and Chandra et al. -U.S. Patent No. 2002/0138582- and Bennett -U.S. Pub. No. 2003/0208429 A1- and Tolopka -U.S. Patent No. 6,064,976- and Lang et al. -U.S. Patent No. 6,694,007 B2) do not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim), wherein the step of automatically implementing the decision includes transmitting an instruction to one or more trading networks, as claimed in claim 23, in conjunction with remaining claims provisions.

The prior art of record (Katz et al. -U.S. Pub. 2002/0174000- and Chandra et al. -U.S. Patent No. 2002/0138582- and Bennett -U.S. Pub. No. 2003/0208429 A1- and Tolopka -U.S. Patent No. 6,064,976- and Lang et al. -U.S. Patent No. 6,694,007 B2) do not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim), transmitting instructions for formulating a second query based on this cumulative response; transmitting instructions for communicating second responses from the plurality of decision-making entities, wherein the second responses comprise revised weighting factors, as claimed in claims 18, and 35, in conjunction with remaining claims provisions.

Response to Arguments

4. Applicant's arguments filed on September 28, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner is establishing motivation in obviousness in the knowledge generally available to one of ordinary skill in the art, to modify the invention of Bennett with the teachings of Tolopka, as explained in the office action.

In response to applicant's arguments that "Bennett does not teach maintaining job classification data for a group of decision making entities" is respectfully acknowledged but is not deemed to be pervasive.

The Examiner contends that a user is indeed a decision maker in the invention of Bennett while the user provides input to the computer to commence a selection or communication across networks, the computer then transmits to another machine that is accessed by a second user thereby providing yet more input to the workflow (job classification). It is well known in the

database art, that a computer is accessed and controlled by a user, which in turn can make a decision by providing input or making selection on the computer. The Examiner has also addressed this argument in the interview summary mailed on 10/14/2004 (Please review the mentioned interview). In addition, the Examiner contends that a computer as recited in Bennett is indeed a memory device. All computer systems run by having a memory.

In response to applicant's arguments that "Bennett does not teach maintaining identification for a group of decision-making entities in a memory device" is respectfully acknowledged but is not deemed to be pervasive.

The Examiner refers to responds stated interview summary dated 10/14/2004 as well as Bennett page 3, paragraphs 0089-0092, wherein the workflow invention includes models of the relationships not only within a project but between projects that can be controlled to provide work assigned and task progress and completion. As work gets routed, the assigned individual can comment, check, verify, and complete the task by providing using an indicator that is posted and viewed by all effected parties. Also see Bennett page 6, paragraphs 0130-0132, wherein a response is entered by a user to indicate their status and that broadly interpreted by the Examiner to read on indicator of support. Also see Bennett page 11, paragraphs 0242, this iconic representation uses a series of bars to indicate the values of the goals.

In response to applicant's argument that " Tolopka teaches away from the current invention" is respectfully considered but is not deemed to be persuasive.

The Examiner's response is that Tolopka clearly states the limitation in the reference cited and whether Tolopka uses the technology in the same manner as the applicant or not is not the intention here but instead the fact that Tolopka teaches such method to exist in itself reads on the limitation of the claim. Tolopka is introduced as a reference in combination with Bennett to teach conducting query from computer to another, which in returns means, from one user to the other. User enters query on a computer screen that is remotely connected to another and receives responses from other user using their input on their computers. The Examiner maintains that a decision-making entity can indeed be the computer as taught by the combination of both references.

In response to applicant's arguments that “Tolopka does not teach wherein each response includes an indicator of support for the proposed action” is respectfully acknowledged but is not deemed to be pervasive.

The Examiner points to the combination of Bennett with Tolopka to teach indicator of support, in Bennett page 6, paragraphs 0131-0135, the user is capable of selecting, accepting, and ranking project tasks. The information is then collected and can be sorted, organized, summarized, and presented in metrics that could be sent across the organization. A scorecard entry tool is being disclosed on page 11, paragraphs 0255-0257 indicating that Bennett's invention that a response from individual users is being tracked and maintained in the system.

In response to applicant's arguments that "Bennett does not teach any proposed action is automatically implement if the cumulative support us greater than the setpoint" is respectfully acknowledged but is not deemed to be pervasive.

The Examiner points to the combined references specifically to Bennett page 7, paragraphs 0136-0137, also see page 14, column 2, lines 35-67 wherein threshold for collected values is disclosed. Since the computer can calculate the necessary figures and a macro can be as such created to accept, report, and output user selected thresholds, its is then read on "automatically". A scorecard entry tool is being disclosed on page 11, paragraphs 0255-0257 indicating that Bennett's invention is capable of tracking metrics according to assigned set points for each individual task and project. Also see Bennett page 15, columns 1, lines 40-67, and see column 2, lines 1-35, wherein Bennett discloses manipulating controls to specify one or objects then the system will condition itself to meet that object or goal.

In response to applicant's argument that "if the references are combined, the result does not address method for data retrieval and access of records in a database", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In addition, refer to response stated in interview summary dated 10/14/2004 for further discussion.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5: 30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 571-272-4038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Neveen Abel-Jalil
January 9, 2005



SAM RIMELL
PRIMARY EXAMINER